

REMARKS

On behalf of the Applicants, Applicants' representatives, Frank J. DeRosa and Matthew Marquardt, gratefully acknowledge the personal interview with Examiner Homere on 18 November 2003.

Applicants' representatives and the Examiner discussed "USING WESTLAW.COM, October 1999 Release," cited by the Examiner, and the version of Westlaw accessed on the Examiner's PC over the Internet on November 18, 2003. The focus of the discussion was on claim 1, and no agreement was reached on the allowability of any claim. Additional comments on the interview are made below.

Drawings

At paragraphs 2 and 3 of the Detailed Action the Examiner objected to the drawings as informal, and to Figs. 1-4 as requiring legends or additional textual descriptive labels.

Approval is requested of the following amendment to Fig. 1. New formal drawings will be submitted after the proposed amendment has been approved.

A

Please insert the following legend in Fig. 1, as shown in red in the attached copy of Fig. 1:

LEGEND (FIGS. 1-4)

- 10 – information collection
- 14 – information unit
- 16 – temporal information (non-leaf node)
- 17 – temporal information (leaf node)
- 20 – topic tree
- 24 – non-leaf node / non-atomic unit
- 26 – leaf node / atomic unit
- 27 – branch
- 28 – stem
- 30 – new branch
- 40 – document

Reconsideration and withdrawal of the objection to the drawings are requested.

Abstract

The Examiner objected to the Abstract (paragraph 4 of the Detailed Action). An amended Abstract is provided above and a clean version of the amended Abstract is provided on a separate sheet attached hereto.

Reconsideration and withdrawal of the objection to the Abstract are requested.

Claim Amendments

A typographical error has been corrected in claim 51.

It is submitted that new claim 55 is allowable.

Rejection of Claims Under 35 U.S.C. § 102

In paragraph 7 of the Detailed Action (page 7), claims 1-54 were rejected under 35 USC § 102(b) as being anticipated by "USING WESTLAW.COM, October 1999 Release" (hereinafter "Using Westlaw"). To anticipate a claim, a

A

single reference must disclose each and every one of the limitations of the claim. As explained below, we respectfully submit that one or more limitations of each of claims 1-55 is not disclosed by the Using Westlaw reference, and therefore not anticipated by that reference. We therefore respectfully traverse and request reconsideration and withdrawal of the rejection of claims 1-54.

Since the discussion at the interview focused on claim 1, we focus our discussion on claim 1, which is reproduced below:

An information collection defining a body of law stored on a computer readable medium, the information collection comprising parts of the body of law that are stored in association with temporal information indicating the applicability with respect to time of the respective part of the body of law, the collection including a plurality of parts of the body of law that are different versions of each other and have different temporal information associated therewith.

We discussed at the interview page 17 of the Using Westlaw reference and the following subject matter in claim 1:

- “parts of the body of law that are stored in association with temporal information indicating the applicability with respect to time of the respective part of the body of law” and
- “a plurality of parts of the body of law that are different versions of each other and have different temporal information associated therewith.”

Page 17 of Using Westlaw includes a screen that page 17 indicates is accessed using the KeyCite feature by entering 49usca48103 into the KeyCite dialog box. As disclosed on page 17 of Using Westlaw, this feature first provides a display of the history of the cited statute illustrated by the screen depicted on page 17. Such history includes four categories listed at the top of page 17 (only

A

the first two of which are shown in the screen depicted on page 17):

- Updating Documents;
- Pending Legislature;
- Credits; and
- Historical and Statutory Notes.

For purposes of discussion only in connection with page 17 of Using Westlaw, we shall assume that Title 49 corresponds to a body of law and that that 49 U.S.C. § 48103 corresponds to a part of the body of law.

At the interview the Examiner maintained with respect to page 17 of Using Westlaw that documents under "Updating Documents" and the current version of 49 U.S.C. § 48103 were different versions of each other (i.e., different versions of a part of a body of law), and that each is stored in association with temporal information indicating the applicability with respect to time of the respective part of the body of law. Applicants' representatives disagreed with this position at the interview, and continue to disagree for the reasons discussed below. In addition, we point out that claim 1 not only calls for "a plurality of parts of the body of law that are different versions of each other," but also that these different versions "have **different** temporal information associated therewith."

The KeyCite screen depicted on page 17 of Using Westlaw lists PL 106-31 and PL 106-59 under "UPDATING DOCUMENTS." These public laws were not available through the KeyCite feature of westlaw.com for 49 USCA § 48103 in the current version of westlaw.com, but are available from other sources.

Attached as Exhibits A and B are copies of PL 106-31 and PL 106-59 obtained

A

from the web site <http://www.gpoaccess.gov/plaws/index.html>.

PL 106-31 (Exhibit A) is an act that makes emergency supplemental appropriations to a number of federal agencies under a number of Titles to the United States Code. Apparently, somewhere in PL 106-31 there is an amendment to 49 U.S.C. § 48103.¹ PL 106-59 (Exhibit B) amends only 49 U.S.C. § 48103, but does so with directions to make specific deletions and insertions.

As to the version of 49 U.S.C. § 48103 in effect in 1999, unfortunately, we were not able to retrieve that version using the KeyCite feature of westlaw.com. Exhibit C contains the current version of 49 U.S.C. § 48103 accessed from westlaw.com using the KeyCite feature, and Exhibit D contains a 1999 version obtained from United States Code Annotated – Historical Version of westlaw.com, which is accessed differently than the KeyCite feature discussed herein and is apparently in a different database. (We discuss the Historical Versions further below.)

We understand the Examiner's position to be that PL 106-31 and 49 U.S.C. § 48103 are different versions of each other, and that PL 106-59 and 49 U.S.C. § 48103 are different versions of each other. The Examiner also stated that claim terms must be given their broadest possible meaning during prosecution.

Making a comparison between PL 106-31 (Exhibit A) and a version of 49 U.S.C. § 48103 (Exhibit C or D), it should be clear that they are not different

¹ The current version of 49 U.S.C. § 48103, Exhibit C, describes the change enacted in PL 106-31 under "Historical And Statutory Notes" for "Pub. L. 106-31."

versions of each other. With respect to PL 106-59 (Exhibit B) and 49 U.S.C. § 48103 (Exhibit C or D), it should be clear that they also are not different versions of each other. A reading of either public law simply does not give one the content of either the prior version (Exhibit D) or the current version (Exhibit C) of 49 U.S.C. § 48103. After reading the public law one knows what changes were made to 49 U.S.C. § 48103, but not how 49 U.S.C. § 48103 read prior to or after the change. To determine how either the prior or current version reads, one must obtain either the prior or the current version. As such, either PL 106-31 (Exhibit A) or P L106-59 (Exhibit B) and 49 U.S.C. § 48103 (Exhibit C or D) cannot be considered different versions of each other.

The Examiner mentioned that that even though a public law shown in the screen depicted on page 17 of Using Westlaw might not be a different version of 49 USCA § 48103, it contained a different version. When we look at Exhibits A and B, we see that this is not the case. As discussed above in connection with Exhibit B (PL 106-59) and the current and prior versions of 49 USCA § 48103 (Exhibit C and D), to determine what the prior version was requires accessing either the prior or current version. PL 105-59 is not enough.

We turn now to a discussion of whether Using Westlaw discloses the subject matter in claim 1 that that the different versions (of the plurality of parts of the body of law that are stored in association with temporal information indicating the applicability with respect to time of the respective part of the body of law) each have **different** temporal information associated therewith.

It is clear that the KeyCite for 49 USCA § 48103 (see Exhibit E for the

A

current version and page 17 of Using Westlaw for the 1990 version) do not include this information. The only dates displayed are those of the public laws under "UPDATING DOCUMENTS." However, these are simply the dates of enactment of the respective public laws, and for a particular public law, the date is the same in the KeyCite and on page 1 of the public law (e.g., see Exhibits A and B). The date of the public law also appears in the body of 49 U.S.C. § 48103 (e.g., see Exhibits C and D). If one interprets the public law and either the KeyCite or § 48103 to be different versions of each other, which as Exhibits A and B demonstrate is not correct, then they each have the same date in the bodies thereof. Even if a public law strikes an entire section or sub-section and replaces it, and the amendment to the statute is the only thing in the public law (an unlikely scenario), such a public law and the current version of the statute section would have the same date, as discussed above, and therefore would not be different versions of the same part having **different** temporal information associated therewith.

At the interview, the Examiner appeared to accept that the information collection described in the patent application was different from westlaw.com (as viewed during the interview) and Using Westlaw. However, the Examiner contended that claim 1 read as broadly as it should be during prosecution anticipated claim 1. Nevertheless, the breath given claim limitations during prosecution cannot be limitless. It is respectfully submitted that "a plurality of parts of the body of law that are different versions of each other and have different temporal information associated therewith" in claim 1, even if interpreted

broadly, does not read on the Using Westlaw reference, as a comparison of Exhibits A and B with Exhibits C and D demonstrates.

Thus, public laws and current versions of statutes or subsections thereof as disclosed in the Using Westlaw reference are not different versions of each other, or do not have different temporal information associated therewith indicating the applicability with respect to time, or both.

For purposes of further comparison, attached as Exhibit E is the currently available KeyCite from westlaw.com for 49 USCA § 48103. Under "UPDATING DOCUMENTS," this KeyCite lists PL 108-176. Attached as Exhibit F is the version of PL 108-76 obtained by selecting the link thereto from the current KeyCite for 49 USCA § 48103. The Examiner is invited to peruse and compare Exhibits E (current version of 49 USCA § 48103), D (current KeyCite for 49 USCA § 48103) and F (version of PL-108-76 obtained through current version of the KeyCite for 49 USCA § 48103). Exhibits C-F were all printed from westlaw.com on April 2, 2004.

It is submitted that an analysis similar to the one set forth above would show that other documents obtained from the KeyCite for 49 USCA § 48103 under the categories "Pending Legislature," "Credits" and "Historical and Statutory Notes," or from a then or now current version of 49 USCA § 48103, would reveal that these documents and the then current version of 49 USCA § 48103 also would not anticipate claim 1, and we understand that the Examiner does not disagree with this.

We understand that the current version of westlaw.com includes prior

versions of the entire United States Code (prior versions of westlaw.com may also have had this feature). One may access a version as it existed in any particular year (going back to 1990) by navigating through "Directory," to a list of "U.S. Federal Materials," to a list of "Statutes," then to "United States Code Annotated - Historical Versions." The desired historical version must then be selected, and keyword-based searching can proceed in the selected historical version.² Even if this westlaw.com feature is available as prior art against this application, it is submitted that this feature does not anticipate or render obvious claim 1 and we understand that the Examiner also agreed with this at the interview.

In view of the foregoing, it is submitted that claim 1 is allowable over the Using Westlaw reference and the prior art discussed herein and other prior art of record.

Independent claims 2-4, 29-31, 36, 41, 46, 47, 50 and 51 all recite language relating to parts (or units) stored in association with temporal information (or date ranges), which are different versions of each other and have different temporal information associated therewith. It is submitted that these claims are allowable over the Using Westlaw reference also.

Claims 51, 53, and 54

In addition to the reasons given above, it is submitted that claims 51, 53, and 54 are allowable as methods of accessing information stored on computer readable media in response to inputting of information identifying a part of a body of law and a date, for example a date of interest. The Using Westlaw reference

² Not all search features otherwise available in westlaw.com are available in the historical versions.

neither discloses nor suggests any system for implementing such a method. In Using Westlaw and in the current version of westlaw.com, it is believed that a user is not offered the option of inputting a date such as a date of interest, in conjunction with information identifying a part of a body of law, for example, in order to specify which of several versions of a body of law the user wishes to access.

Dependent Claims

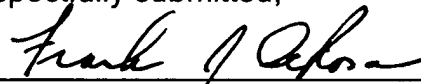
It is submitted that the dependent claims are allowable based on their incorporation of subject matter in independent claims shown above to be allowable. The dependent claims also include subject matter upon which patentability can be based. However, since the discussion above is believed to moot the rejections of the dependent claims, the Examiner's specific comments relating to the dependent claims will not be specifically addressed herein, although Applicants reserve the right to do so later in this proceeding or a subsequent proceeding.

Closing

It is submitted that claims 1-55 are allowable. Early reconsideration and allowance of the application with claims 1-55 are respectfully requested.

Dated: April 2, 2004

Respectfully submitted,



Frank J. DeRosa
Reg. No. 26,543
BROWN RAYSMAN MILLSTEIN
FELDER & STEINER LLP
900 Third Avenue
New York, New York 10022
(212) 895-2010
(212) 895-2900 FAX